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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,719	12/03/2003	Keith A. Thuerk	BOC9-2003-0077 (448)	6364
40987	7590	07/07/2009		
Novak Druce + Quigg LLP CityPlace Tower, 525 Okeechobee Blvd. Fifteenth-Floor WEST PALM BEACH, FL 33401			EXAMINER FRITZ, BRADFORD F	
			ART UNIT 2442	PAPER NUMBER
			MAIL DATE 07/07/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/726,719	<b>Applicant(s)</b> THUERK, KEITH A.	
	<b>Examiner</b> BRADFORD F. FRITZ	<b>Art Unit</b> 2442	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-10 and 38-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-10 and 38-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 4/21/09 have been fully considered but they are not persuasive.
2. In the remarks, applicant argued in substance that:

(A) Prior art does not teach selecting a group of inactive subscribers in an inactive state from the list of subscribers in the graphical user interface.

As to point (A), the Examiner respectfully disagrees. Quillen teaches selecting a group of inactive subscribers (Fig. 7c and 8) in an inactive state from the list of subscribers in the graphical user interface (column 12, lines 37-39 and column 10, lines 35-41). Quillen clearly states that an alert (*alerting the user when a contact(s) go from offline to online*) can be set for a single contact (icon 520) or a **set of contacts** (icon 825) (column 12, lines 37-39).

(B) Prior art does not teach that the at least one designated action is to be automatically performed with respect to each subscriber in the group in response to a state change.

As to point (B), the Examiner respectfully disagrees. Quillen teaches at least one designated action is to be automatically performed with respect to each subscriber in

Art Unit: 2442

the group in response to a state change (column 12, lines 37-39 and column 10, lines 35-41).

(C) Prior art does not teach automatically detecting a state change of at least one of the subscribers in the group; and automatically executing the designated action associated with the group for the at least one subscriber responsive to the detecting step.

As to point (C), the Examiner respectfully disagrees. Quillen teaches automatically detecting a state change of at least one of the subscribers in the group (column 12, lines 37-39); and automatically executing the designated action associated with the group for the at least one subscriber responsive to the detecting step (column 10, lines 35-41 and column 12, lines 45-51).

(D) Prior art does not teach automatically executing a designated action to a group of inactive subscribers when a state change is detected for the group of inactive subscribers.

As to point (D), the Examiner respectfully disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *automatically executing a designated action to a group of inactive subscribers when a state change is detected for the group of inactive subscribers*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are

Art Unit: 2442

not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Nevertheless, Quillen teaches that an alert can be set for an entire group to alert the user when a state change is detected (offline to online) for the group of inactive subscribers. Quillen clearly states that an alert (*alerting the user when a contact(s) go from offline to online*) can be set for a single contact (icon 520) or a **set of contacts** (icon 825) (column 12, lines 37-39). Also, Quillen states that any of the right click actions that can be performed on the icons can also be carried out inside the buddy list window as well (column 1, lines 40-45).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 8-10, 38-41, and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable by Wick (6,691,162) in view of Quillen (7,266,776), hereinafter referred to as Quillen.

5. Regarding claims 1, 38, and 45, Wick disclosed displaying a user selectable list of subscribers of an instant messaging service; selecting a subscriber in an inactive state from the list (column 5, lines 6-55 and Fig. 5), designating at least one action

Art Unit: 2442

associated with the [subscriber], the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a state change (column 5, lines 6-55 and Fig. 5 and 4); automatically detecting a state change of at least one of said subscribers in said group (column 5, lines 6-55 and Fig. 5).

However, Wick does not explicitly teach selecting a group of subscribers within a list, designating at least one action with the group, the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a state change, automatically executing said designated action associated with said group for said at least one subscriber responsive to said detecting step. Quillen teaches selecting a group of subscribers within a list (column 10, lines 35-40 and column 12, lines 36-50), designating at least one action with the group (column 10, lines 35-40 and column 12, lines 36-50), the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a state change (column 10, lines 35-40 and column 12, lines 36-50), automatically executing said designated action associated with said group for said at least one subscriber responsive to said detecting step (column 10, lines 35-40 and column 12, lines 36-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Quillen in the system of Wick because both are from the same field of endeavor and in order to “facilitate communications between computer users across a network” (see *title*).

6. Regarding claims 2 and 39, Wick disclosed wherein said action is an instant messaging initiation action that initiates an instant messaging session between said client and said at least one subscriber (column 5, lines 6-55 and Fig. 5).

7. Regarding claims 3 and 40, Wick disclosed wherein said action includes at least one action selected from the group consisting of a notification action (column 5, lines 6-55 and Fig. 5), a prompting action (column 5, lines 6-55 and Fig. 5), and a message conveyance action (column 5, lines 6-55 and Fig. 5).

8. Regarding claims 4 and 41, Wick disclosed wherein said selecting, said designating, said associating, said detecting, and said executing steps are performed by said instant messaging client (column 5, lines 6-55 and Fig. 5).

9. Regarding claims 8 and 43, Wick disclosed wherein said state change is a change from an inactive state to an active state (column 5, lines 6-55 and Fig. 5).

10. Regarding claims 10 and 44, Wick disclosed presenting within a graphical user interface a list of said subscribers (column 5, lines 6-55 and Fig. 5), and within said graphical user interface (Fig. 4-5), visually distinguishing said at least one subscriber from other subscribers in said list (column 5, lines 6-55 and Fig. 5).

11. Claims 5 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wick in view of Quillen, further in view of Ogle et al. (6,430,604), hereinafter referred to as Ogle.

12. Regarding claims 5 and 42, Wick and Quillen disclosed the invention as described above. However, neither explicitly teaches wherein said instant messaging client includes a Lotus Sametime (TM) type client. Ogle teaches wherein said instant

Art Unit: 2442

messaging client includes a Lotus Sametime (TM) type client (column 1, 20-33). It would have been obvious to one of ordinary skill in the art at the time of invention to include the Lotus Sametime IM client in the system of Wick and Quillen because all are from the same field of endeavor of instant messaging and in order to use Wick's "pounce" with another IM client.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRADFORD F. FRITZ whose telephone number is (571)272-3860. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2442

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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